

REMARKS/ARGUMENTS

The foregoing amendments to the claims are of formal nature, and do not add new matter. Claims 119-124 are pending in this application and are rejected on various grounds. Claims 122 and 124 have been canceled without prejudice or disclaimer. Claim 119 has been amended for clarity. The rejections to the presently pending claims are respectfully traversed.

Priority

Applicants submit that they rely on the chondrocyte proliferation assay (Example 160) for patentable utility for this application. This data was first disclosed in the International Application No. PCT/US00/08439, filed March 30, 2000, the priority of which is claimed in the present application. Hence, Applicants are entitled to at least an effective filing date of **March 30, 2000.**

Information Disclosure Statement

Applicants submit an IDS separately enlisting references recited in the Blast report in order to be compliant with 37 C.F.R. § 1.98(a)(1). Consideration of this Information Disclosure Statement is respectfully requested.

Specification

A. The disclosure was objected to by the Examiner as containing “embedded hyperlink and/or other form of browser-executable code.” The foregoing amendment to the specification which deleted all embedded hyperlinks, is believed to overcome the present objections.

B. Applicants have amended the title to better describe the claimed invention. Accordingly, Applicants believe that the objections to the specification should be withdrawn.

Claim Objections

A. Applicants have amended claims 119 to remove references to Figures in the claim language. Hence this objection should be withdrawn.

Claim Rejections – 35 U.S.C. §112, Second Paragraph

A. Claims 122 was rejected under 35 U.S.C. §112, second paragraph, for being indefinite. The Examiner alleges that it was unclear how an antibody can be both an antibody and a fragment.

Applicants have canceled Claim 122 and amended Claim 119 to recite "an antibody, or a fragment thereof," as suggested by the Examiner and therefore this rejection should be withdrawn.

B. Claim 124 was rejected for reciting "specifically binds" especially since, Claim 119 recites "binds." Without acquiescing to the propriety of this rejection and solely in the interest of expedited prosecution in this case, Applicants have canceled Claim 124 and amended Claim 119 to recite "specifically binds." Accordingly, claims are now definite and this rejection should be withdrawn.

Claim Rejections – 35 U.S.C. §102

A. Claims 119-124 are rejected under 35 U.S.C. §102(e) as being anticipated by Ni *et al.*, (U.S.P.N. 6,566, 498).

Applicants have canceled Claim 124 and have amended Claim 119 to recite "specifically binds to the polypeptide of SEQ ID NO: 345."

Applicants submit that the term "specifically binds" has a well established meaning, and is understood by those skilled in the art to mean that the antibody binds to a particular polypeptide, and does not significantly bind to another polypeptide. Since claim terms should be given their ordinary, art-recognized meaning, the present rejection is believed to be misplaced, and should be withdrawn.

Claim Rejections – 35 U.S.C. §103

A. Claims 119-124 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ni *et al.* (2003) in view of Goldenberg (1989).

As discussed above, since Applicants refer to antibodies that "specifically binds" to SEQ ID NO:345 over Ni's sequence, Ni does not teach the antibodies encompassed by this invention. Hence, the primary reference, Ni *et al.* falls as prior art. Further, Goldenberg does not teach or

anticipate antibodies that specifically bind SEQ ID NO: 345 of the instant application either. Therefore, the present claims are not obvious under §103 over Ni in view of Goldenberg and hence, this rejection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641, referencing Attorney's Docket No. 39780-2730 P1C28).

Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: August 10, 2004

By: Daphne Reddy
Daphne Reddy (Reg. No. 53,507)

HELLER EHRMAN WHITE & McAULIFFE LLP
275 Middlefield Road
Menlo Park, California 94025
Telephone: (650) 324-7000
Facsimile: (650) 324-0638

SV 2053085 v1
8/10/04 9:45 AM (39780.2730)